Supreme Court, U.S.
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No. 94-683

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1994

BB ASSET MANAGEMENT, INC., Transferee
Through Brown Bag Software, Inc.
Petitioner

vs.

SYMANTEC CORPORATION and JOHN L. FRIEND,
an individual and dba SOFTWORKS DEVELOPMENT
Respondents

Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

OPPOSITION BRIEF OF RESPONDENT SYMANTEC CORPORATION

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QUESTIONS PRESENTED

1. Notice That Summary Judgment Was Sought:

A. Should this Court grant certiorari to consider whether respondents' summary judgment motion "state[d] the *grounds* for [summary judgment] with sufficient particularity,"[1] when petitioner Brown Bag never placed that issue before the Ninth Circuit, having instead asked the Ninth Circuit to decide whether Brown Bag "didn't realize summary judgment was being sought on its Lanham Act claim"?[2]

B. Did Brown Bag have notice that defendants were seeking summary judgment against the False Designation of Origin/Lanham Act claim when:

- Both moving parties' notices of motion unequivocally stated that defendants were moving for summary judgment on *all* of Brown Bag's claims;
- Moving defendant Friend's memorandum in support of summary judgment contained a section titled "False Designation of Origin (Fourth Claim)"; and
- Moving defendant Symantec's memorandum expressly recited all of the factual allegations of the Lanham Act claim and specifically contended that there was no evidence to support any of them?

2. Waiver: Can Brown Bag's substantive contentions regarding its "trade dress" claim be considered on the merits when:

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1 Petition for Writ of Certiorari ("Petition" or Pet."), p. i, emphasis added.

2 Ninth Circuit Memorandum filed June 28, 1994 ("Ninth Cir. Mem."), App. p. d3.

(a) Brown Bag unambiguously waived the claim in the district court by failing to mention or argue in favor of the Lanham Act claim in response to the summary judgment motions;

(b) the Ninth Circuit squarely held that the trade dress issue was waived because "the issue was [first] raised after the record on summary judgment was closed, [and] Brown Bag's opposition to summary judgment contains neither argument nor evidence pertaining to its claim for false designation of origin";[3] and

(c) any decision on the merits of the trade dress issue would be moot since Brown Bag has not asked this Court to review the Ninth Circuit's holding that the claims were waived?

*3. **Distinctiveness Standard:*** Did the Ninth Circuit err in holding that Brown Bag's failure to offer evidence of inherent distinctiveness and failure to offer evidence of secondary meaning would have doomed the trade dress claim even if it had been timely raised?

*4. **"Look and Feel" as Trade Dress:*** Is this case a suitable vehicle for considering the contention that the overall "look and feel" (whatever that may mean) of a computer program constitutes trade dress where Brown Bag failed to introduce the entire programs into evidence, never so much as uttered the words "trade dress" in the district court, created no relevant record, and proffered no evidence of essential elements of a trade dress claim?

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3 *Id.*

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BRIEF IN OPPOSITION OF RESPONDENT SYMANTEC CORPORATION

INTRODUCTION

This Petition is Brown Bag's sixth effort to persuade a federal court that there is any merit to its claims in this lawsuit and its second effort to convince this Court that there was error of such gravity and significance that this Court should grant certiorari. Each previous effort failed. So must this one, for the Petition is utterly baseless and there is absolutely no reason to grant certiorari. The principal holding of the Ninth Circuit's unexceptional, unpublished ruling was that petitioner — after receiving due notice of a summary judgment motion — waived

its Lanham Act claim by failing to mention the Lanham Act claim in its opposition to summary judgment, by never once even referring to trade dress prior to the close of evidence in the district court proceedings, and by offering neither argument nor evidence in defense of the claim.

In light of Brown Bag's total indifference toward its Lanham Act claim in the district court, its insistence on pursuing the issue on appeal and in this Court is inexplicable except as an exercise in vexatious, spiteful litigation. There is no reason for this Court to devote its scarce resources to a review of such matters.

STATEMENT OF FACTS AND OF THE CASE

Notwithstanding certain inadequacies of petitioner's Statement of the Case, a few salient facts are sufficient for this Court to confirm that review by this Court would be inappropriate, indeed, pointless on the record herein.

A. Complaint and Discovery

On June 8, 1988, Brown Bag sued Symantec and Friend, alleging claims for copyright infringement, for violation of the Lanham Act, and for various state law wrongs. The Fourth Claim for Relief, titled "False Designation of Origin," is comprised in its entirety of a boilerplate paragraph incorporating the preceding allegations of the complaint (¶ 32), a paragraph alleging damages (¶ 35), and the following two paragraphs which contain all of Brown Bag's substantive allegations in support of its Lanham Act claim:

> "33. Defendants and their agents falsely promote [their computer software program] GrandView as being an upgrade, derivative or improvement upon [plaintiff Brown Bag's computer program] PC-OUTLINE in a manner to suggest a connection with Plaintiff. No such connection exists, and Plaintiff and Defendants are competitors. Such acts constitute a violation of Section 43(a) of the Trademark Laws of the United States.

> "34. The advertising, marketing and promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-OUTLINE. There is a likelihood of confusion, mistake or deception." (Complaint [District Court Docket No. 1], p. 9.)

The Complaint included no reference whatever to trade dress.

Although the Lanham Act claim was the subject of only limited discovery, defendant John Friend succeeded in identifying all of the facts that Brown Bag contended supported the claim. On October 11, 1988, Friend served contention interrogatories on Brown Bag. Under compulsion of one of the Magistrate's seven (7) discovery orders against Brown Bag and its principal Sanford Schupper (Docket No. 76), Brown Bag finally responded:

> "INTERROGATORY No. 31:
> "Do you contend that 'Defendants and their agents falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in a manner to suggest a connection with Plaintiff' as alleged in Paragraph 33 of your Complaint? If so, state each fact on which you base your contention.
> ...
>
> "RESPONSE TO INTERROGATORY NO. 31:
> "Symantec offers GrandView to PC-Outline owners at a drastically reduced price. GrandView can even accept PC-Outline files. John Friend even said on CompuServe [an electronic computer "bulletin board"], 'Once PC-Outline users use GrandView, they'll never look back.'"

(Plaintiff's Responses to First and Second Set of Interrogatories From Defendant John Friend (Warner Decl. in

Supp. S.Jmt., Exh. B [Docket No. 131]), pp. 42-43, hereafter "Br. Bag Interrog. Resp. [Docket No. 131]".)[4]

Brown Bag neither supplemented nor amended these discovery responses, which the defendants relied on in their summary judgment motions.

Symantec's and Friend's Motions for Summary Judgment

Following the close of discovery, defendant Symantec filed a Notice of Motion and Motion for Summary Judgment "on all of plaintiff's causes of action against defendant Symantec." The Notice of Motion specifically stated that there was an absence of evidence that Symantec falsely and misleadingly promoted GrandView as being an upgrade, derivative or improvement upon PC-Outline. (Docket No.120.) On the same day, John L. Friend moved for summary judgment "with respect to each of the claims of the Complaint." (Docket No. 129.) Each defendant also filed a supporting memorandum of law which specifically indicated that the false designation of origin claims were at issue. (Docket Nos. 127, 205.)

On April 19, 1989, Brown Bag filed "Plaintiff's Opposition to Both Defendants' Motions for Summary Judgment." (Docket No. 137.) Brown Bag's opposition brief offered no argument whatsoever in opposition to summary judgment on its Lanham Act claim, did not state that there was any evidence to support the Lanham Act claim, and did not mention or allude in any way to Brown Bag's Lanham Act cause of action.

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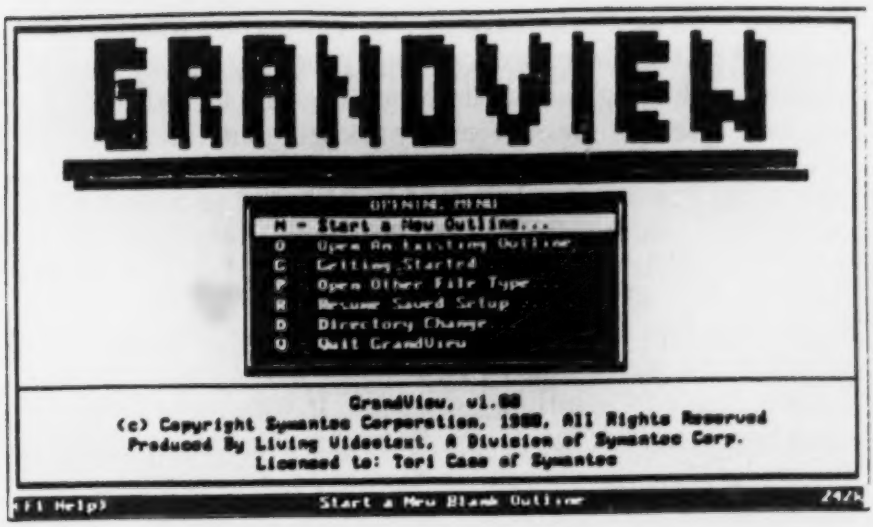
4 Friend's Interrogatory no. 32 similarly asked for every fact on which was based the contention of Paragraph 34 of the Complaint that "'the advertising, marketing and promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-Outline'"; Brown Bag's only response was to reference another interrogatory answer (No. 6), in which Brown Bag merely identified six reviews of the GrandView product.

Brown Bag did not state at any point in the summary judgment proceedings that the overall look and feel of its PC-Outline program constituted trade dress. Brown Bag did not state at any point in the summary judgment proceedings that GrandView's trade dress was confusingly similar to PC-Outline's. The evidence that was before the district court included neither the entire computer programs at issue nor any product packaging, and no declarant's testimony indicated that the total effect of GrandView's packaging and user interface could lead any consumer to believe that GrandView came from Brown Bag.

One of the screen displays submitted by Symantec did, however, bear on whether a user confronted with the computer screen displays of the two programs might be confused about whether she was using Symantec's GrandView program or Brown Bag's PC-Outline program. It was undisputed that each time a user of the programs began a session with one of the programs, the computer displayed a "opening menu" screen which identified the source of the programs. Below, we reproduce those initial "opening menu" screen displays for GrandView and PC-Outline. (Case Decl. in Supp. Mot.Strike, Exh. A [Docket No. 145].)


GRANDVIEW
OPENING MENU
N - Start a New Outline...
O Open An Existing Outline
G Getting Started
F Open Other File Type
R Resume Saved Setup
D Directory Change
Q Quit GrandView
GrandView, v1.00
(c) Copyright Symantec Corporation, 1988, All Rights Reserved
Produced By Living Videotext, A Division of Symantec Corp.
Licensed to: Tori Case of Symantec
Start a New Blank Outline

WELCOME TO PC-OUTLINE - HAVE FUN!
OPENING MENU
Open a new outline
Load an Existing Outline
Drive/Dir
Quit
(c) Copyright 1986,87 Brown Bag Software, All Rights Reserved
Directory C:\PCO

The overall appearance of these opening screens is manifestly different. It is impossible to imagine anyone confusing the two. PC-Outline's opening screen display says "WELCOME TO PC-OUTLINE," and identifies "Brown Bag Software" as the copyright holder. GrandView, on the other hand, is identified in distinctive letters more than one inch tall, and the screen display clearly states: "Produced by Living Videotext, A Division of Symantec Corporation." No wonder Brown Bag decided not to introduce such evidence relating to its claim! Given these screen displays, any claim that a user might confuse the two programs or believe that GrandView comes from Brown Bag is ludicrous.

On September 7, 1989, following the reply briefs, an in-court demonstration of the two programs and supplemental letter briefing, the district court ruled on the summary judgment motions. *Telemarketing Resources v. Symantec Corp.*, 12 U.S.P.Q.2d (BNA) 1991 (N.D. Cal. 1989). The court granted summary judgment against Brown Bag's copyright claims, dismissed without prejudice the pendant state claims, and omitted to rule expressly on the Lanham Act claims. *Id.* at 1996.

Subsequent Proceedings

Brown Bag's first appeal followed. The Ninth Circuit (i) affirmed the grant of summary judgment against Brown Bag's copyright claims, (ii) upheld the Magistrate's exercise of discretion providing Brown Bag with only limited, conditional access to confidential documents belonging to its competitor Symantec, and (iii) remanded Brown Bag's Lanham Act claim for clarification as to whether or not the district court had intended to grant summary judgment.[5] *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465 (9th Cir. 1992).

Although the Ninth Circuit held that "Brown Bag [had] failed to offer any evidence pertaining to the Lanham Act

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5 The first two issues were the subject of Brown Bag's previous certiorari petition (No. 92-178).

claim, and therefore failed to carry its evidentiary burden in opposing summary judgment," the court declined "to infer a district court's decision on an entire claim." *Brown Bag*, 960 F.2d at 1477, 1478. "We therefore remand the Lanham Act claim for such clarification and for further proceedings as the district court deems necessary in light of our opinion." *Id.* at 1478.

On or about June 25, 1992, Brown Bag filed its first petition for certiorari, which was denied on October 5, 1992 (113 S.Ct. 198). The case was thereupon returned to the district court for clarification as the Ninth Circuit had ordered.

Following a status conference at which the parties were heard, but no new evidence offered or received, on November 12, 1992 the district court entered its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim:

> "Although not stated expressly in its previous order granting summary judgment, the court had intended to grant summary judgment on all federal claims, i.e. the trademark claim as well as the copyright infringement claim. This order amends and clarifies the previous summary judgment and GRANTS Defendants' motion for summary judgment on the trademark claim under the Lanham Act for false designation of origin.'
>
> ". . . [I]n its opposition , *Plaintiff presented no evidence* in support of its claim for false designation of origin. In fact *Plaintiff did not even mention the Lanham Act in its opposition brief.*" (Pet. App. p. b3, emphasis added.)

On November 25, 1992 the district court entered Judgment Nunc Pro Tunc, granting judgment on the Lanham Act claim nunc pro tunc to September 7, 1989. Brown Bag thereafter took its second appeal. The Ninth Circuit affirmed in an unpublished memorandum decision filed June 28, 1994.

REASONS FOR DENYING THE WRIT

I.

THE SUFFICIENCY OF THE NOTICES OF MOTION TO ADVISE BROWN BAG THAT SUMMARY JUDGMENT WAS SOUGHT IS NOT AN ISSUE WHICH REQUIRES THIS COURT'S ATTENTION

Petitioner slyly seeks to substitute a new claim for the one that was presented to and decided by the Ninth Circuit. This is understandable because the claim asserted in the appeal — that "the moving parties [failed to] provide adequate notice that they were moving for summary judgment on Brown Bag's Lanham Act" claim (Open.Br. p.2) — is patently indefensible. Instead, Brown Bag asks this Court to grant certiorari so that it can address a different issue from the one Brown Bag put before the Ninth Circuit, namely, whether the statement of the "grounds" for the summary judgment motion was sufficiently detailed.

Neither issue, however, is meritorious and neither issue warrants this Court's attention, particularly since the Ninth Circuit's unpublished ruling is of no significance to anyone other than the immediate parties to this dispute.

A. Brown Bag Was Plainly On Notice That Summary Judgment Was Sought Against Its Lanham Act Claim.

Under *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), when a party "point[s] out to the district court . . . that there is an absence of evidence to support the nonmoving party's case," the nonmoving party is obliged to "come forward with all of [its] evidence." 477 U.S. at 325, 326. The district court in this case granted summary judgment against Brown Bag's Fourth Claim for Relief, observing that Brown Bag failed,

after notice, to present evidence in support of its false designation of origin claim. (Pet. App. pp. b2-4.)

On appeal, Brown Bag made the extraordinary claim that there was an issue as to whether Brown Bag knew the defendants were moving for summary judgment on the claim: "Did the moving parties provide adequate notice that they were moving for summary judgment on Brown Bag's Lanham Act trade dress claim for false designation of origin?" Opening Brief p. 2. The Ninth Circuit correctly rejected the claim:

> "Even though Brown Bag argues that it didn't realize summary judgment was being sought on its Lanham Act claim, Symantec's notice of motion indicates that it sought judgment on all claims; moreover, the grounds offered in support include the absence of evidence that Symantec falsely promoted GrandView as being an upgrade, derivative, or improvement upon PC-Outline, tracking exactly Brown Bag's fourth claim for relief." (Pet. p. d3.)

Brown Bag's claim of surprise is completely disingenuous, and the issue is wholly frivolous. The record belies any claim there was insufficient notice. Indeed, four separate pleadings put Brown Bag on notice that the Lanham Act claim, among others, was the subject of the summary judgment motion.

First, Symantec's March 31, 1989 Notice of Motion and Motion for Summary Judgment stated in relevant part:

> "[D]efendant Symantec Corporation ('Symantec') will move this Court for an Order Granting Summary Judgment in favor of Symantec pursuant to Federal Rules of Civil Procedure, Rule 56, ***on all of plaintiff's causes of action*** against defendant Symantec." (Docket No. 120, emphasis added)

Symantec's Notice of Motion further stated:

> "This motion for summary judgment is based on the grounds that ... (4) ***there is no evidence that***

> *Symantec or its agents falsely promoted GrandView as being an upgrade, derivative or improvement upon PC-Outline* in [a] manner as to suggest a connection with plaintiff or to mislead consumers as to the source of GrandView." (Docket No. 120, emphasis added)

Second, defendant Friend's Notice of Motion and Motion for Summary Judgment also informed Brown Bag:

> "[D]efendant John L. Friend will move the Court for an Order Granting Summary Judgment in his favor and against [Brown Bag] *with respect to* ***each of the claims*** *of the Complaint*." (Docket No. 129, emphasis added)

Finally, both of the defendants' legal memoranda clearly identified the issue, referenced the relevant allegations of plaintiff's Fourth Claim for Relief, the Lanham Act claim, and specifically stated that there was no evidence to support the allegations.[6]

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[6] Friend's Memorandum of Points and Authorities in Support of Motion for Summary Judgment (Docket No. 205) includes a section titled "False Designation of Origin (Fourth Claim)." The section stated: "In this claim, plaintiff contends that defendants falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in violation of Section 43(a) of the Lanham Act. Complaint, ¶33. ... [P]laintiff is unable [to] show that defendants are promoting GrandView as being connected with or a derivative of PC-Outline." (Docket No. 205, pp. 23-24, original emphasis.)

Symantec's memorandum in support of summary judgment did not mention the words "Fourth Claim for Relief," but it recited every substantive allegation of ¶¶ 33 and 34 of the Complaint and stated "that there is no evidence to sustain [those] allegations." (Docket No. 127, p. 38, fn.24.) "Symantec further contends that there is no evidence to sustain the allegations that Symantec or its agents falsely promote GrandView as being an upgrade, derivative or improvement upon PC-Outline in a manner as to suggest a connection with plaintiff, nor is there any evidence that the

Brown Bag complains about the fact that one of the references to its Lanham Act claim was a footnote to a section of Symantec's memorandum which addressed state law claims and Brown Bag also disputes the relevance of part of Friend's legal analysis. (Pet. pp. 17-18.) But its counsel (the same here as in the district court) does not state that he never read the footnotes nor that he did not read the two Notices of Motion nor the section in defendant Friend's brief headed, "False Designation of Origin (Fourth Claim)." Possibly, the Federal Rules may be amended one day to require multimedia notices, sound bites or scratch-and-sniff stickers to attract the attention of counsel. For now, however, we understand the Rules as embodying a conclusive presumption of literacy on the part of counsel for a party. A Notice of Motion which explicitly states that all claims are being attacked on summary judgment puts the party on notice of what it says.

B. Brown Bag 's Contention That the Grounds For the Motion Were Insufficiently Stated Is Equally Meritless.

It is not entirely clear why petitioner contends that the grounds for the summary judgment were stated with insufficient particularity or what the contentions means. But this Court need not detain itself over this variant of the issue presented to the Ninth Circuit for three reasons.

First, if Brown Bag is saying anything different from the above argument that it did not realize defendants were moving for summary judgment, it has no right to ask this Court to consider it for the first time. This Court cannot review issues never presented to the Courts of Appeal.

Second, it is unnecessary and impossible to state the grounds for the motion with any more particularity than the defendants did. Brown Bag's Lanham Act claim alleged

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advertising, marketing or promotion of GrandView is such that consumers are led to believe it comes from the same source as PC-Outline ....." (*Id.*) *Compare* with substantive allegations of Complaint, Fourth Claim for Relief (Docket No. 1, p. 9:12-20).

certain facts. Defendants knew that the factual allegations were a sham and lacked any basis whatever. As expressly authorized by this Court's decision in *Celotex Corp.v.Catrett*, 477 U.S. 317 (1986), they clearly so stated, identifying the specific factual allegations and elements of the claim which defendants contended were baseless. That was sufficient under Rule 56 and under established law.

Third, "the parameters of FRCP 7's requirement that the grounds of motions be stated with particularity" (Pet. p. i) cannot be defined in the abstract, but is a matter to be raised in district court if a party truly cannot comprehend the basis of a motion. Defendants' motions made it quite clear that they sought summary judgment on the Lanham Act claim. If Brown Bag actually did not understand the basis of the motions, Brown Bag should have objected there and then — not for the first time years later on appeal or in a petition for certiorari. Still less is it imaginable that this Court should engage in the business of parsing motions to see whether they should be more specific, after a district court and a court of appeals has considered the sufficiency of the notice.

In the face of the record, Brown Bag's contention that there is an issue about whether defendants "provide[d] adequate notice that they were moving for summary judgment" on the false designation of origin cause of action is not merely frivolous, it is deceitful.

II.

BROWN BAG WAIVED ANY TRADE DRESS CLAIM BY FAILING TO ASSERT IT IN TIMELY FASHION

Petitioner asks this Court to take up certain supposedly novel issues concerning its contrived trade dress claim, but petitioner entirely ignores the basis of the Ninth Circuit's actual ruling, a ruling which would render moot any decision this Court could render on the submitted issues. Although the Ninth Circuit commented, in the alternative, on the inadequacy of Brown Bag's factual showing as to the "distinctiveness" of

Brown Bag's alleged trade dress, that court's principal holding — which Brown Bag does not allude to and does not ask this Court to review — was that Brown Bag simply waived the issue:

> "[Brown Bag's] argument fails because the [trade dress] issue was raised after the record on summary judgment was closed, [and] Brown Bag's opposition contains neither argument nor evidence pertaining to its claim for false designation of origin . . . ." (Pet. p. d3.)

The Ninth Circuit's holding was inescapable, for it is established beyond peradventure that an issue not argued to the district court is waived on appeal.[7] In this case, not only did Brown Bag fail to raise its trade dress theory of false designation of origin during the course of the summary judgment proceedings, Brown Bag failed to raise *any* argument or theory in defense of its Lanham Act claim. Brown Bag did not even let the trial judge know that Brown Bag opposed summary judgment on the Lanham Act claim. As the district court noted in its Order Granting Summary Judgment on Plaintiff's Lanham Act Claim, "Plaintiff did not even *mention* the Lanham Act in its opposition brief." (Pet. App. p. b3.) Even though Brown Bag was put on notice that the Fourth Claim for Relief (among others) was at issue, Plaintiff's Opposition to Both Defendants' Motions for

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7 *Dumas v. Gommerman*, 865 F.2d 1093, 1095 fn. 3 (9th Cir. 1989) ("Since this argument was not presented at the district court level, it cannot be raised for the first time on appeal"); *Pye v. Mitchell*, 574 F.2d 476, 480 (9th Cir. 1978) ("[Appellants] tender this argument for the first time on appeal. That is too late.... Where an issue is conceded below, it cannot be raised for the first time on appeal."); *Liberles v. County of Cook*, 709 F.2d 1122, 1126 (7th Cir. 1982) ("It is a well-settled rule that a party opposing a summary judgment motion must inform the trial judge of the reasons, legal or factual, why summary judgment should not be entered. If it does not do so, and loses the motion, it cannot raise such reasons on appeal.").

Summary Judgment chose to remain totally silent about the Lanham Act claim.

Having failed to tell the district court there was any reason not to grant summary judgment on the Lanham Act claim — having abandoned the issue by failing to tell to the district court that Brown Bag desired to defend the claim at all — Brown Bag was barred from raising the claim on appeal.[8]

There is no basis for overturning the finding of waiver, and — of critical importance to this Court's jurisdiction — Brown Bag has not requested this Court to do so. In asking this Court to consider other, substantive issues without asking the Court to review the Ninth Circuit's finding of waiver, petitioner asks this Court to render advisory opinions concerning the other issues.

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8 Brown Bag did present argument on its trade dress theory at the district court's November 26, 1992 status conference, following the Ninth Circuit's remand to clarify the earlier ruling, but it was three years too late for Brown Bag to argue in defense of its Lanham Act claim. The Ninth Circuit neither *reversed* the district court's earlier judgment nor ordered the district court to *reopen* the summary judgment proceedings. Rather, the court of appeals only directed the district court, on remand, to *clarify its earlier ruling*. As indicated by the entry of judgment "nunc pro tunc" and by the district court's explanation of its order granting summary judgment, the district court did precisely that. The clarification was that the district court had intended to grant summary judgment on the Lanham Act claim as part of its September 7, 1989 judgment. (Pet. App. pp. b3, c2.) Having failed to argue in favor of its Lanham Act at any time prior to the submission of the summary judgment issues for decision in May 1989, Brown Bag has waived its Lanham Act Claim for Relief.

III.

THE NINTH CIRCUIT CORRECTLY APPLIED THE LAW ON "DISTINCTIVENESS" OF TRADE DRESS

Brown Bag asks the Court to review the issue: "Are distinctiveness and secondary meaning both indispensable elements of a trade dress cause of action?" (Pet. p. i [Question Presented II]). There is no reason to grant certiorari to consider that issue because this Court recently resolved the question in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. __, 120 L.Ed.2d 615, 112 S. Ct. 2753 (1992), unambiguously holding that a trade dress claimant need not show secondary meaning if the trade dress was proven inherently distinctive.

Brown Bag contends that the Court of Appeals erroneously believed that *both* distinctiveness and secondary meaning must be shown, pointing to the language from the Ninth Circuit's memorandum decision which states that "there is no evidence raising a triable issue of fact on distinctiveness and secondary meaning -- which are indispensable elements." Although the formulation is arguably ambiguous, there is no reason to believe that the Ninth Circuit did not understand the correct standard, no reason to believe that it misapplied that standard, and no reason for this Court to parse the factual record of this case in order to supervise the court of appeal's supervision of the application of summary judgment standards to the routine facts of this case.

First, the Ninth Circuit did not apply the wrong legal standard. Both parties' appeal briefs cited *Two Pesos* and both parties clearly advised the court of appeals that "inherent distinctiveness" and acquired "secondary meaning" are *alternative* means of demonstrating the distinctiveness

necessary for a trade dress claim.[9] It is therefore unimaginable that the Ninth Circuit misapprehended the law. What the Ninth Circuit obviously intended to express were its conclusions — again not subject to serious dispute — that there was no evidence of inherent distinctiveness *and* no evidence of secondary meaning, and that it is indispensable that a plaintiff present evidence of one of the two elements.

Second, the conclusion that there was no evidence of either inherent distinctiveness or secondary meaning is unimpeachable. Although Brown Bag now asserts that evidence of "copying" is sufficient to raise a triable issue concerning secondary meaning, in reality there was no evidence of copying either![10]

Third, even if Brown Bag had presented to this Court a marginally credible claim that the district court and the Ninth Circuit both erred in their application of summary judgment standards to the meager "evidence" submitted by Brown Bag, Brown Bag states no reason why the Supreme Court should grant review. Petitioner does not appear to understand that this Court's role is not to look over the shoulder of every court of appeals to make sure it does its job. The Ninth Circuit, it is undisputed, applied the established legal standards in

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9 Brief of Defendant-Appellee Symantec Corporation, p. 23; Opening Brief for Plaintiff-Appellant Brown Bag Software, p.22.

10 Respondent Symantec pointed out to the district court and to the Ninth Circuit that Brown Bag was bound by its interrogatory responses. One of those interrogatory responses specifically asked Brown Bag whether it contended that "Friend [had] knowingly and willfully copied ... PC-Outline," and if so, to state all facts on which Brown Bag based its contention of copying. Brown Bag's entire answer was: "Obviously due to the fact that Friend admittedly wrote both PC-Outline and GrandView solely on his own." Br. Bag Interrog. Resp. [Docket No. 131], pp. 11-12. The "facts" identified in Brown Bag's answer were insufficient to create a triable issue on whether PC-Outline's trade dress had secondary meaning.

reviewing *de novo* the district court's grant of summary judgment. Petitioner fails to explain what was so unusual in the Ninth Circuit's unpublished decision as to warrant this Court's attention.

IV.

THIS CASE IS NOT A SUITABLE VEHICLE FOR CONSIDERING THE CIRCUMSTANCES IN WHICH THE "LOOK AND FEEL" OF A COMPUTER PROGRAM MIGHT CONSTITUTE TRADE DRESS.

Brown Bag asks the Court to consider the supposedly novel question of whether the (undefined) "look and feel" of a computer software program can constitute a form of trade dress protectable under the Lanham Act. The case is not suited for and in fact defies such review for two related reasons.

A. The Record Is Completely Undeveloped On The Trade Dress Issue.

Since the trade dress issue was never raised until after the close of discovery and after the record was closed on summary judgment, both the facts and the legal considerations pertaining to this difficult and disturbing issue were completely undeveloped in the district court. It would be imprudent for this Court to attempt to assess the implications of such an expansion of the "trade dress" doctrine in a case in which the issues have neither been fully developed in discovery nor fully analyzed in the proceedings leading to judgment. No discovery in this case could focus on trade dress since the petitioner did not even hint at any such theory until the case was on appeal. Even the scope of the claim is undefined, since the term "look and feel" has no well-settled or precisely-defined meaning either in the computer software industry or in legal parlance. The scope, consequently, of Brown Bag's trade dress claim is therefore unknown and unknowable.

Among the issues to be carefully assessed, if this Court were some day to consider the application of the trade dress doctrine to the "total image" of computer software programs, are the following: Just what is the "look and feel" of a program, and does that formulation refer to something different from the more common term, "user interface"? Does it matter if the computer program at issue is a video game, a stand-alone business application or something else? Is the user interface at issue primarily textual or graphic? To what extent, if any, is the user interface known to consumers when they make their purchase decision? If computer software is prominently labeled as to source at the point of sale, can alleged similarities of user interfaces nonetheless generate consumer confusion? Are user interfaces entirely functional in character? What evidence is there that consumers actually consider any unusual aspects of a user interface to be "distinctive" in the trademark sense — meaning indicative of source? If the entirety of a product, as it is perceived by consumers, is asserted to constitute its "trade dress," what implications does this have for the presumptions often applied to trademark analysis under the Lanham Act? And, perhaps most important, if the user interface of a program is not protectable under copyright or patent law, can the very same elements be effectively withdrawn from the public domain merely by being dubbed "trade dress"?

Few, if any, of these important questions can be meaningfully explored in this case because of the paucity of the record; and if this Court granted certiorari in order to address such issues, the Court would not have the benefit of the thinking of the district court or of the courts of appeal, since the petitioner raised its trade dress theory too late for these difficult legal issues to have been considered below. Certiorari is inappropriate in such circumstances.

B. Plaintiff Presented Insufficient Evidence To Withstand Summary Judgment

It would be pointless for this Court to render an opinion on whether a computer program's "look and feel" is protectable as trade dress, in the abstract, when in the case at hand the

plaintiff clearly failed to make a sufficient showing to withstand summary judgment even if "look and feel" can be trade dress. Three points ineluctably compel this conclusion.

1. The Only Facts Stated In Brown Bag's Discovery Responses Were Insufficient To Establish Any Of The Necessary Elements Of A Trade Dress Claim.

To prevail on a trade dress claim, a plaintiff must show that its trade dress is inherently distinctive or has acquired secondary meaning, that it is nonfunctional, and that there is a likelihood defendant's trade dress will be confused with plaintiff's. *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 826 F.2d 837, 841 (9th Cir. 1987). None of the purported facts stated in support of the Lanham Act claim in the interrogatory response quoted above (Docket No. 131) is sufficient to create an issue of material fact on any of these issues:

- "*Symantec offers GrandView to PC-Outline owners at a drastically reduced price.*" Vigorous price competition is neither an infringement of trade dress nor probative of any fact relevant to trade dress.
- "*GrandView can even accept PC-Outline files.*" This feature — which refers to file compatibility — actually tends to refute any Brown Bag claim of nonfunctionality, but is probative of no other trade dress issue.
- "*John Friend even said on CompuServe, 'Once PC-Outline users use GrandView, they'll never look back.'*" This statement of GrandView's superiority has nothing to do with trade dress and certainly does not establish likelihood of confusion or any other Lanham Act element.

The listed "facts" do not remotely suggest that PC-Outline has inherently distinctive trade dress or secondary meaning nor that its look and feel is nonfunctional nor that consumers are likely to be confused by GrandView's user interface. Summary judgment was, consequently, compelled.

2. Brown Bag Never Submitted The Essential Evidence For A Trade Dress Claim, The Entire Programs And Their Packaging.

Brown Bag's Lanham Act claim represents an effort to exhume its defunct "total look and feel" copyright claim by affixing to the same claim the label "trade dress." However, Brown Bag closes its eyes to an insuperable obstacle to its claim, namely, that Brown Bag never submitted, in its opposition to summary judgment, the only direct evidence of the programs' "overall look and feel" — the complete programs themselves, including their packaging. One of the critical issues in a trade dress case is "whether there is a likelihood of confusion resulting from *the total effect of the defendant's product and package* on the eye and mind of the ordinary purchaser." *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383-84 (9th Cir. 1987), emphasis added. Accord, *Roulo v. Russ Berrie & Co.*, 886 F.2d 931, 936 (7th Cir. 1989), cert. denied, 493 U.S. 1075 (1990) (trade dress encompasses "overall appearance of a product" including packaging). Yet Brown Bag introduced neither any product packaging nor the "total" products GrandView and PC-Outline in opposing summary judgment. Since the presentation of the entire programs, with their packaging, is clearly an essential predicate to any conclusion that consumers could be confused by the "total effect of the defendant's product and package on the eye and mind of the ordinary purchaser," *First Brands*, Brown Bag's omission was fatal to its Lanham Act trade dress claim.

3. The Fragmentary Evidence Proffered By Brown Bag Did Not Create A Genuine Issue Of Material Fact On Any Of The Necessary Elements Of A Trade Dress Claim.

Even if, in opposing to summary judgment, Brown Bag were permitted to adduce facts beyond its discovery responses, none of the evidence Brown Bag submitted in support of its copyright claim would be sufficient to sustain

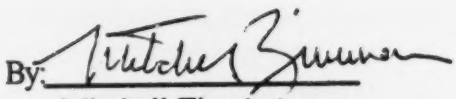
the trade dress claim. Brown Bag had not devised its trade dress theory at the time it filed its opposition to summary judgment on its copyright claim, hence Brown Bag never explained how the evidence submitted at that time related to the essential elements of a trade dress claim — nonfunctionality, distinctiveness, or likelihood of confusion. The evidence in fact supports none of those elements. Brown Bag's petition does not even attempt to explain how, from that evidence, an inference could be drawn that there is a triable issue as to each of the required elements. Since there is not, even if all other obstacles could be overcome, affirmance of the district court judgment would still be required.

CONCLUSION

Petitioner Brown Bag's six-year vendetta against the defendants brings it to this Court a second time, on claims even more clearly devoid of merit than those previously asserted. The Petition raises no issues worthy of this Court's attention. Respondent Symantec respectfully prays that the Court deny the petition.

DATED: November 9, 1994

FENWICK & WEST

By: 

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